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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/790,941

03/01/2004

Joseph Miller

S63.2-10812-US01

2180

490 7590 05/01/2008  
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EXAMINER

COZART, JERMIE E

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

05/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/790,941	<b>Applicant(s)</b> MILLER ET AL.	
	<b>Examiner</b> Jermie E. Cozart	<b>Art Unit</b> 3726	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 20-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 1,2,10-12,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 4-9 and 22-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Appeal Brief***

1. In view of the appeal brief filed on 1/21/08, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/David P. Bryant/  
Supervisory Patent Examiner, Art Unit 3726

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 10, 11, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ching et al. (US 6,481,262 B2).

Regarding **claims 1**, Ching discloses positioning assembly of a crimper apparatus (10) comprising a first plate (50) and a second plate (20), the first plate having a nest (1n; see FIG. 2 below) located between ribs (44) to accommodate at least a portion of a first cylindrical member (60), the second plate (20) having a nest (2n; see FIG. 2 below) located between ribs (24) to accommodate at least a portion of a second cylindrical member (61). The first nest (1n) and the second nest (2n) aligned along the longitudinal axis (see FIG. 6). The first plate (50) constructed and arranged to be separated from the second plate (20) in a first position. The first plate (50) and the second plate (20) are moveable relative to one another (col. 4, lines 26-30) in the longitudinal direction [see Fig. 2, i.e. the first plate (50) is inserted first and placed in member (30) then the second plate (20) is moved longitudinally so as slide above plate (50) into groove (34) of member (30)], in a first position [see Fig. 2, i.e. the first plate (50) is inserted first and placed in member (30) then the second plate (20) is moved longitudinally so as slide above plate (50) into groove (34) of member (30)] the first plate (50) is constructed and arranged to be separated from the second plate (20) in the longitudinal axis and in a second position (see fig. 1) the first plate (50) closer to the second plate (20) than in the first position, when in the second position the first plate (50) and the second plate (20) situated such that the first cylindrical member and the second cylindrical member would be in predetermined placement for joining.

Regarding **claim 2**, the first plate (50) has a nest (described above, see also fig. 6) longitudinally aligned with a nest (described above, see also fig. 6) on the second plate (20).

Regarding **claim 10**, the first cylindrical member is a stent retaining member (not labeled, see fig. 6).

Regarding **claim 11**, the second cylindrical member is a catheter tube (60).

Regarding **claim 20**, Ching discloses a first plate (50) and a second plate (20), the first plate having a first nest (1n) to accommodate at least a portion of the catheter, the second plate (20) having a second nest (2n) to accommodate at least a portion of the marker (i.e. stent). The first plate (50) moveable relative the second plate (20) along the length of the catheter between the first and second positions, the first plate (50) biased toward one of the positions. Note that the catheter and marker are not part of the positioning assembly, therefore these limitations (i.e. catheter and marker) have not been given patentable weight because the claim is solely directed to a “positioning assembly” and not the combination of a positioning assembly, catheter, and marker.

Regarding **claim 21**, Ching discloses a first plate (50) and a second plate (20), the first plate (20) having a first nest (1n) to accommodate at least a portion of the catheter (60), the second plate (20) having a second nest (2n) to accommodate at least a portion of the marker (i.e. stent). The first plate (50) and second the second plate (20) moveable relative to one another to adjust a distance between the first nest (1n) and the second nest (2n) as measured along the length of the catheter (60). Note that the catheter and marker are not part of the positioning assembly, therefore these limitations

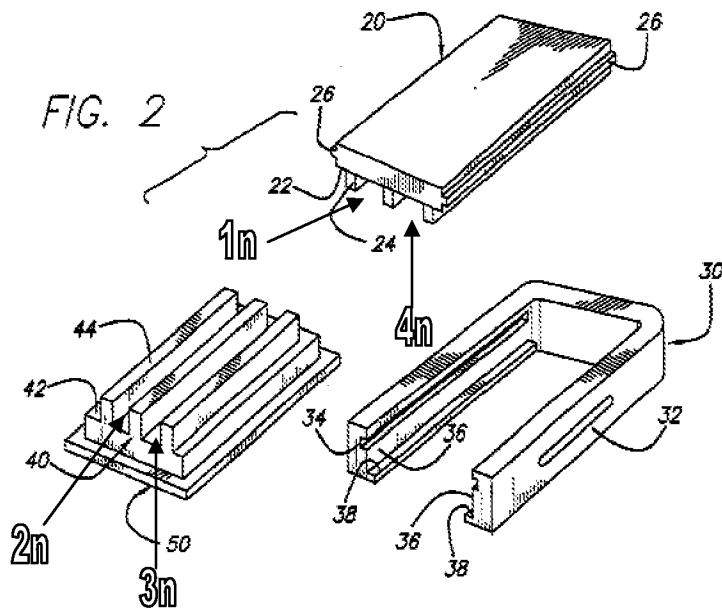
Art Unit: 3726

(i.e. catheter and marker) have not been given patentable weight because the claim is solely directed to a “positioning assembly” and not the combination of a positioning assembly, catheter, and marker.

*See column 3, line 64 – column 5, line 12, and figures 1, 2, and 6 for further clarification.*

Note that the recitation “for automatically positioning a second cylindrical member for crimping to a first cylindrical member, the first cylindrical member defining a longitudinal axis” and “for automatically positioning a marker for crimping a catheter” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Note also that for the purposes of the above rejection, the longitudinal direction of the cylindrical members and the plates have been treated as being different, since the claims are directed solely to the positioning assembly and not the combination of the positioning assembly and first and second cylindrical members.



**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ching et al. (US 6,481,262 B2).

Ching discloses the first cylindrical member being a catheter tube.

Ching, however, does not expressly disclose the second cylindrical member being the inner tube of a catheter.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the second cylindrical member as the inner tube of a catheter because Applicant has not disclosed that the second cylindrical member being the inner tube of a catheter

provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the second cylindrical member being a catheter tube because the apparatus effectively crimps the first and second cylindrical members onto one another.

Therefore, it would have been an obvious matter of design choice to modify Ching to obtain the invention as specified in claim 12.

### ***Response to Arguments***

6. Applicant's arguments filed 1/21/08 have been fully considered but they are not persuasive.

Applicants argue that Ching does not teach a plate that is moveable along the longitudinal axis of the catheter (60).

In response, the Examiner maintains that for the purposes of the above rejection with respect to Ching, the longitudinal direction of the plates (see Figs. 2 and 6) have been treated as being different because the claims are directed solely to the positioning assembly and not the combination of the positioning assembly and first and second cylindrical members. In Fig. 5 of Ching, both the first cylindrical member and the second cylindrical member have a longitudinal axis extending in a longitudinal direction. In Fig. 2 of Ching, the first plate (50) and the second plate (20) are moveable relative to one another (col. 4, lines 26-30) in the longitudinal direction [see Fig. 2, wherein the first plate (50) is inherently inserted first and placed in member (30) then the second plate (20) is moved longitudinally so as to slide above plate (50) into groove (34) of member



(30)]. Therefore, both the first cylindrical and the second cylindrical member have a longitudinal axis extending in a longitudinal direction which is separate and distinct from the first plate and the second plate that are moveable relative to one another in the longitudinal direction as described above in detail.

***Allowable Subject Matter***

7. Claim 3 is allowed.
8. Claims 4-9 and 22-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie E. Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3726

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jermie E Cozart/

Primary Examiner, Art Unit 3726

April 28, 2008